

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IK-HYUN KIM

Appeal No. 1999-2594
Application No. 08/777,720

Heard: Oct.11, 2001

Before BARRETT, DIXON, and GROSS, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4 and 8-16, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellant's invention relates to a method for printing of a list of outgoing abbreviation numbers (speed dial) in a facsimile machine in response to a predetermined condition being met. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A process for transmitting an abbreviation number list in a facsimile system, comprising the steps of:

determining whether an abbreviated dial number corresponds to one of telephone numbers registered in said facsimile system for automatic dialing, in response to user input of said abbreviated dial number from an operational panel;

when said abbreviated dial number does not correspond to one of the telephone numbers registered in said facsimile system, successively counting each time the user input of abbreviated dial numbers not registered in said facsimile system, and automatically printing a list of registered abbreviated dial numbers with corresponding telephone numbers registered in said facsimile system for user dialing information, when a count value of the user input of the abbreviated dial numbers not registered in said facsimile system reaches a predetermined value;

when said abbreviated dial number corresponds to one of the telephone numbers registered in said facsimile system, automatically dialing a corresponding telephone number registered for said abbreviated dial number;

determining whether a stop key is input by the user from said operational panel during said dialing of the corresponding telephone number registered for said abbreviated dial number;

when said stop key is input by the user from said operational panel during said dialing of the corresponding telephone number registered for said abbreviated dial number, successively counting each time the user input of said stop key from said operational panel, and automatically printing a list of registered abbreviated dial numbers with corresponding telephone numbers registered in said facsimile system for user dialing information, when a count value of the user input of said stop key reaches said predetermined value.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Fukushima et al. (Fukushima)	5,293,256	Mar. 08, 1994
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Claims 1-4 and 8-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fukushima.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed Oct. 27, 1998) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed Aug. 18, 1998) and reply brief (Paper No. 18, filed Dec. 28, 1998) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant argues that Fukushima does not teach or fairly suggest the printing of a list of registered abbreviated dial numbers after a predetermined number of entries of 1) dial numbers not corresponding to the telephone numbers registered in the facsimile system, or 2) dial numbers that were registered in the system, but stopped in response to the user actuating a stop key. (See brief at page 6.) We agree with appellant. Further, we note that the examiner admits that Fukushima does not teach the above limitations, but the examiner maintains that the invention, as claimed, would have been obvious. (See answer at page 5.) The examiner maintains that Fukushima identifies the same problem and provides a print key to print the list of abbreviated facsimile numbers. (See answer at page 6.) We disagree with the examiner. While the problem of Fukushima is similar and the solution is similar, we find that the teachings of Fukushima are only directed to the printing of labels for the keys and for the memory cards used. Therefore, we find no suggestion or motivation to count the number of entries of abbreviated dial numbers made in error or entries of correct abbreviated dial numbers which are stopped using the stop key and then print out the list of registered abbreviated telephone numbers.

The examiner goes on at great length in the answer on pages 6-20 in an attempt to rationalize the difference between the Fukushima and the claimed invention, but we do not find the examiner's arguments persuasive. The examiner maintains that appellant goes about solving the problem in a tedious and time-consuming manner. (See answer at page 8.) We disagree with the examiner's statement. As discussed above, we find the problem to be slightly different and the solution thereto also different. The "more succinct manner" (*id.*) of Fukushima is only a recognition by the examiner of a difference which the examiner has not shown to be obvious in light of the teachings of Fukushima.

The examiner's conclusion on page 6 of the answer that it would be obvious to replace the print key with counting the predetermined conditions is unsupported by evidence in Fukushima or by a convincing line of reasoning why one skilled in the art would have modified the express teachings of Fukushima. Therefore, we find that the examiner has not established a ***prima facie*** case of obviousness, and we will not sustain the rejection of independent claim 1. Similarly, we will not sustain the rejection of independent claims 2, 9, and 10 and their dependent claims 3, 4, 8, and 11-16.

CONCLUSION

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To summarize, the decision of the examiner to reject claims 1-4 and 8-16 under 35
U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

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